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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,339	01/16/2002	Jose Duez	28944/37661	8636

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EXAMINER

PRUNNER, KATHLEEN J.

ART UNIT PAPER NUMBER

3751

DATE MAILED: 04/05/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/913,339	Applicant(s) DUEZ ET AL.
Examiner Kathleen J. Prunner	Art Unit 3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 November 2003.
- 2a) This action is FINAL.
- 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 19-47 is/are pending in the application.
 - 4a) Of the above claim(s) 40 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 19-39 and 41-47 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 - Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 - Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 - 1. Certified copies of the priority documents have been received.
 - 2. Certified copies of the priority documents have been received in Application No. _____.
 - 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Drawings

1. The proposed drawing corrections received on November 21, 2003 (Paper No. 13) have been approved. In order to avoid abandonment, the drawing informalities noted in Paper No. 10, mailed on July 18, 2003, must now be corrected. Correction can only be effected in the manner set forth in the above noted paper.

Specification

2. The following informalities in the specification are noted: (A) in the paragraph beginning at page 9, line 11, on line 3 of the paragraph, "valve" should be deleted since no valve structure is shown. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 31, 32, 46 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 31 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationship is: the phrase "having at least one orifice allowing the product to pass from the reservoir to the application head", on lines 3-4, renders the claims indefinite because it is unclear how this "at least one orifice" structurally relates to the "at least one orifice" recited in claim 19. It is suggested that line 3 of claim 31 be amended to read --base

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adaptable to the body of the device.-- and line 3 of claim 46 be amended to read --to at least a portion of the central surface of a base adaptable to the body of the device.-- and that line 4 of both claims 31 and 46 be deleted in its entirety in order to overcome this rejection.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 19-23, 29, 31-39, 41, 42, 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumann et al. in view of Gueret ('143). Baumann et al. disclose a device for applying a product such as cosmetics or shaving cream (note lines 62-66 in col. 2) having the claimed features including a body (constituted by the container structure of sleeve member 1) including a reservoir constituted by inner compartment 6 (note lines 58-63 in col. 2), an application head (constituted by applicator element 8 and cover member 7) having the bristles of a brush (note lines 70-74 in col. 2) fixed on the support formed by cover member 7 having an orifice or material discharge opening 15, the application head being adaptable to the body 1 (note Fig. 1), and means for conveying the product from the reservoir 6 to the application head constituted by the piston member 2 and the threaded spindle 3. Although Baumann et al. disclose that a small brush can be used as the applicator element 8 (note lines 71-74 in col. 2) but fails to describe the length of the bristles forming such a brush, attention is directed to Gueret ('143) who discloses another product applying device using an application head formed by brush bristles having a length ranging from 8 to 40 mm and preferably from 11 to 20 mm (note lines 5-10 in col. 3) in order to provide an applicator which allows the product to be applied rapidly while at the same time conveying much more product than a conventional brush such that it is possible to deposit a layer thickness greater than with a conventional brush (note lines 43-49 in col. 1). It would have been obvious to one of ordinary skill in the brush applicator art, at the time the invention was made, to form the bristles of Baumann et al. having a length ranging from 8 to 20 mm in view of the teachings of Gueret in order to provide an applicator which allows the

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product to be applied rapidly while at the same time conveying much more product than a conventional brush such that it is possible to deposit a layer thickness greater than with a conventional brush. With respect to claim 20, Gueret further teaches the obviousness of using a bristle length less than 15 mm (note lines 5-10 in col. 3). With respect to claim 21, Gueret also teaches the obviousness of using a bristle length of not more than 10 mm (note lines 5-10 in col. 3). With regard to claim 22, Gueret additionally teaches the obviousness of using a bristle length that is not less than 5 mm (note lines 5-10 in col. 3). With regard to claims 23 and 47, the support formed by cover member 7 in Baumann et al. inherently forms a backing. With respect to claim 29, Gueret further teaches the obviousness of forming the brush bristles of synthetic materials or natural materials (note lines 11-20 in col. 3). With respect to claim 31, Baumann et al. also disclose that the support (formed by cover member 7) is fixed to at least a portion of the central surface (at projection 12) of a base (constituted by bottom cap 4) (note Fig. 1) and that the base 4 is adaptable to the body 1 of the device. With regard to claim 32, Baumann et al. further disclose that the outside edge of the base 4 is rounded (note lines 20-22 in col. 2). With regard to claim 33, Gueret also teaches the obviousness of using a bristle diameter between approximately 15 μm and 60 μm , i.e., approximately 15/100th of a mm and approximately 60/100th of a mm (note lines 13-15 in col. 3). With respect to claim 34, Gueret additionally teaches the obviousness of using a bristle diameter between approximately 20 μm and 40 μm , i.e., approximately 20/100th of a mm and approximately 40/100th of a mm (note lines 39-41 in col. 3). With respect to claim 35, Gueret further teaches using a bristle diameter between approximately 35 μm and 40 μm , i.e., approximately 35/100th of a mm and approximately 40/100th of a mm (note lines 39-41 in col. 3). With respect to claims 36-38, although Baumann et al. fail to describe the specific density of bristles used in forming the brush applicator, nonetheless, to select a density within the claimed range would be considered mere routine experimentation to the artisan skilled in the brush applicator art determined solely by the particular material from which the bristles are made, the particular product being dispensed as well as by the particular type of coverage to be made to the applied surface and would simply be

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the result of optimization of the prior art teachings through routine experimentation, which is not a matter of invention, absent a showing to the contrary (see *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955), *In re Hoeschele*, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969), and MPEP § 2144.05). With regard to claim 39, Baumann et al. further disclose a foaming cream product, such as shoe cream or shaving cream (note lines 58-67 in col. 2). With regard to claim 41, Baumann et al. also disclose that the application head is fixed to the body 1 and the body is a non-aerosol container structure or can. With regard to claim 42, Baumann et al. additionally disclose that the body 1 is integrated with the reservoir 6 (note lines 62-63 in col. 2). With respect to claim 46, Baumann et al. also disclose that the bristles are fixed to at least a portion of the central surface of a base (formed by the top horizontal surface of the body 1) (note Fig. 3) adaptable to the body 1 of the device.

8. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baumann et al. in view of Gueret as applied to claims 19-23, 29, 31-39, 41, 42, 46 and 47 above, and further in view of Goncalves. It is considered that the orifice 15 in Baumann et al. constitutes a slit type of opening. Although Baumann et al. fail to disclose the materials forming the applicator head, attention is directed to Goncalves who discloses another brush type applicator in which the applicator is made of flexible plastic material which is rigid and elastically deformable (note lines 8-10 in col. 2) so that it is of simple construction and adaptable for all kinds of containers (note lines 47-49 in col. 1). It would have been obvious to one of ordinary skill in the brush applicator art, at the time the invention was made, to form the brush applicator head of Baumann et al. of flexible plastic material which is rigid and elastically deformable in view of the teachings of Goncalves in order to form an applicator head that is of simple construction and adaptable for all kinds of containers.

9. Claims 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumann et al. in view of Gueret as applied to claims 19-23, 29, 31-39, 41, 42, 46 and 47 above, and further in view of Barber, Jr. With respect to claims 25 and 27, although Baumann et al. fail to disclose the specific material forming the backing support of the brush applicator, attention is directed to

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Barber, Jr. who discloses another brush applicator having a backing (note from line 65 in col. 16 to line 33 in col. 17) formed by a network, i.e., a woven fabric, of polyester threads resulting from an association of weft and warp threads (note lines 13-19 and 29-30 in col. 17) in order to form a backing which is flexible and exhibits substantial conformability to whatever surface it is being applied to (note lines 13-16 in col. 17). It would have been obvious to one of ordinary skill in the brush applicator art, at the time the invention was made, to form the backing support of Baumann et al. by a network, i.e., a woven fabric, of polyester threads having a weft and warp in view of the teachings of Barber, Jr. in order to form a backing which is flexible and exhibits substantial conformability, when in use, to whatever surface it is being applied to. With regard to claim 26, although Baumann et al. fail to disclose how the brush bristles are attached to the support backing, attention is directed to Barber, Jr. who discloses another brush applicator having the bristles attached or fixed to a backing by weaving or bonding (note lines 29-32 in col. 17). It would have been obvious to one of ordinary skill in the brush applicator art, at the time the invention was made, to form the brush of Baumann et al. by weaving or bonding in view of the teachings of Barber, Jr. in order to form a flexible, supple brush that is easily conformable, when in use, to whatever surface it is being applied to. With regard to claim 28, although Baumann et al. fail to disclose the specific material forming the backing support of the brush applicator, attention is directed to Barber, Jr. who discloses another brush applicator having a backing (note from line 65 in col. 16 to line 33 in col. 17) formed by polyester reinforced with elastomer (note lines 13-23 in col. 17) in order to form a backing which is flexible and exhibits substantial conformability, when in use, to whatever surface it is being applied to.

10. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baumann et al. in view of Gueret as applied to claims 19-23, 29, 31-39, 41, 42, 46 and 47 above, and further in view of Donsky. Although Baumann et al. fail to disclose from what specific material the bristles of the brush applicator are formed, attention is directed to Donsky who discloses another brush applicator in which the bristles are formed of mohair. It would have been obvious to one of ordinary skill in the brush applicator art, at the time the invention was made, to form the

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bristles of Baumann et al. from mohair in view of the teachings of Donsky in order to provide a brush made of natural origin to comply with ecological conservation concerns.

11. Claims 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumann et al. in view of Gueret as applied to claims 19-23, 29, 31-39, 41, 42, 46 and 47 above, and further in view of Webster. Baumann et al. further disclose that the shaving product container structure 1 is a piston operated reservoir device. Although Baumann et al. fail to disclose that the shaving product container structure 1 can be formed with a flexible and deformable bag reservoir which is surrounded by propellant gas, attention is directed to Webster who discloses another shaving product container structure (note lines 28-30 in col. 7) in which the container structure is a pressurized container or can having a flexible and deformable bag (note lines 35-38 in col. 1 and 34-36 in col. 2) which is surrounded by propellant gas (note lines 44-51 in col. 6) and that uses a valve in order to dispense the product in controlled amounts (note lines 5-11 in col. 1) when a non-foamy gel shaving product is to be dispensed (note lines 32-37 in col. 1). It would have been obvious to one of ordinary skill in the applicator art, at the time the invention was made, to form the shaving product container structure of Baumann et al. as a can or container formed with a reservoir defined by a flexible and deformable bag surrounded by propellant gas in view of the teachings of Webster in order to dispense a non-foamy gel shaving product in controlled amounts. With respect to claim 44, although Webster fails to describe the specific gas used for the propellant gas, to use compressed air as the propellant gas is considered to be obvious to one of ordinary skill in the applicator art especially when complying with or taking into account the environmental and ecological concerns regarding the ozone layer and atmospheric conditions. With regard to claim 45, Baumann et al. further disclose that the application head is fixed to the container; Webster further teaches the obviousness of using a valve 16 of ring or annular shape (note Fig. 1 and lines 6-9 in col. 4).

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Election/Restrictions

12. Applicant's election of the species of Figs. 5a-e in Paper No. 9 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

13. The requirement is still deemed proper and is therefore made FINAL.

Response to Arguments

14. Applicant's arguments filed November 21, 2003 (Paper No. 12) have been fully considered but they are not deemed persuasive.

15. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching and motivation is found in the references themselves as clearly pointed out in the above rejection of the claims.

16. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the issues of the shape of the bristles when wet or the efficacy of the foaming effect when the product to be distributed is a shaving cream) are not recited in the rejected claim(s) or described in the originally filed disclosure. Although the claims are interpreted in light of the specification, limitations not in the originally filed specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

17. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

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combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kathleen J. Prunner whose telephone number is 703-306-9044.

20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson can be reached on 703-308-2580. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Kathleen J. Prunner

April 1, 2004